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REMARKS

In response to the Office Action, claims 1-4, 8-10, 14-16, 20-22, 26-28 and 32-34 have been amended. Claims 5, 11, 17, 23, 29 and 35 have been canceled. Accordingly, claims 1-4, 6-10, 12-16, 18-22, 24-28, 30-34 and 36 are pending, of which claims 1, 7, 13, 19, 25 and 31 are independent.

Claims 1-36 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,706,568 (hereafter the '568 patent). The Examiner has taken the position that the claims of the present invention are not patentably distinct from the '568 patent, because the '568 merely omits the step of "forming an oxide film on a surface of the above semiconductor film," and such a step is obvious.

Applicant respectfully disagrees. Importantly, the claims of the '568 patent do not recite that "a wavelength of the second laser beam and a wavelength of the third laser beam are different from a wavelength the first laser beam," as recited in independent claims 1, 7, 13, 19, 25 and 31, of the present application. The Examiner dismisses this distinction as being *inherent* because the claims of the '568 patent recite "the energy density of the third laser is higher than the energy density of the first laser." As set forth in MPEP 2112 a mere statement that the claimed features are inherent is not enough to support such a rejection. The Examiner is required to provide an explanation as to why said inherency would necessarily exist or flow from the prior art. Therefore, the Examiner's assertion that claim 1 of the '568 patent recites all of the steps of the claims of the instant application is clearly unsupportable. Should the Examiner maintain the above rejection, Applicant respectfully requests that the filing of a terminal disclaimer be held in abeyance until the claims are in condition for allowance.

Claims 7-12 stand rejectable if claims 13-18 are found allowable. The Examiner asserted that claims 13-18 will be objected to under 37 C.F.R. 1.75 as being a substantial duplicate of claims 7-12.

As fully set forth in previous responses, claims 7 and 13, recite different claim language. Claim 7 recites "*radiating* the semiconductor film with a *second laser beam* after radiating with the first laser beam under an atmosphere comprising one of hydrogen and an inert gas," while claim 13 recites "*radiating* the semiconductor film with a *third laser beam*

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after radiating with the second laser beam under an atmosphere comprising one of hydrogen and an inert gas," (*emphasis added*). The scope of claims 7 and 13 are different. Claim 7 further defines the second radiation step, while claim 13 further defines the third radiation step.

Applicant respectfully submits that the above-mentioned exemplary features of claims 7 and 13 are clearly different. Because the scope of the claims are different and not merely different due to "a slight difference in wording" the objection is not proper. Claim 7 and claim 13 do not recite the same invention as alleged by the Examiner. Should the Examiner maintain this objection the undersigned respectfully requests that an explanation be provided as to why and how the second and third radiation steps of claim 7 are duplicates of the second and third radiation steps of claim 13.

Claims 1 has been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,304,329 to Nita et al. ("Nita").

Amended claim 1 recites a method for manufacturing a semiconductor device comprising forming a semiconductor film over an insulating surface and forming an oxide film on the semiconductor film. The semiconductor film is radiated with a first laser beam using a lens. The semiconductor film is radiated with a second laser beam after radiating with the first laser beam, and radiated a third laser beam after radiating with the second laser beam. A wavelength of the second laser beam and a wavelength of the third laser beam are different from a wavelength of the first laser beam.

Nitta does not disclose the steps of "radiating the semiconductor film with a first laser beam using a lens; radiating the semiconductor film with a second laser beam after radiating with the first laser beam; and radiating the semiconductor film with a third laser beam after radiating with the second laser beam," as recited in amended claim 1.

In contrast, Nitta discloses laser diodes 52, 53 and 54 (such as shown in Fig. 12) that are provided in order to detect the angular velocity off the other object, and the laser diodes are utilized in a ring resonator in a gyro. Therefore, Nitta does not disclose radiating the semiconductor film with laser beams as recited in Applicant's claimed invention, which is directed to a method of manufacturing a semiconductor device wherein a semiconductor film is crystallized by laser radiation. Moreover, as Nitta is related to a gyro having a plurality of laser diodes, and although Nitta teaches how the laser diodes are made, Nitta does not teach,

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disclose or suggest, for example, the steps of forming a semiconductor film over an insulating surface, radiating the semiconductor film with a first laser beam, forming an oxide film, etc., as recited in Applicant's amended claim 1.

Furthermore, Nitta does not disclose or suggest radiating the semiconductor film with a first laser beam "using a lens," as recited in amended claim 1.

As fully set forth in MPEP 2131, a claim is only anticipated if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference, since each and every feature of the present claims is not disclosed within the four corners of Nitta, the rejection of claim 1 under 35 U.S.C. §102(e) is improper.

Moreover, in addition to not establishing anticipation of claim 1, Nitta is insufficient prior art because it is non-analogous to the claimed invention. MPEP 2141.01(a) requires that a reference must either be in the field of applicant's endeavor or if not then be reasonably pertinent to the particular problem with which the invention was concerning Nitta's laser diodes is not pertinent to the claimed steps of the present invention.

Given the above, Applicant respectfully submits that claim 1 is allowable over the cited prior art.

Claims 2, 3, 7-9, 11, 13-15, 17, 25-28 and 31-33 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Nitta and further in view of U.S. Patent No. 5,808,321 to Mitnaga et al. ("Mitnaga").

Claims 2 and 3 have been amended to overcome the Examiner's functional recitation objection. Amended claim 2 recites that "a crystallized semiconductor film is formed after radiating the semiconductor film with the first laser beam." Amended claim 3 recites that "the oxide film on the semiconductor film is removed after radiating the semiconductor film with the second laser beam."

Applicant respectfully submits that Mitnaga does disclose the claimed subject matter as it fails to cure the deficiencies of Nitta because it does not recite the claimed radiating steps of claim 1.

Claim 7 recites a method for manufacturing a semiconductor device comprising forming a semiconductor film over an insulating surface, and forming an oxide film on the semiconductor film. The semiconductor film is radiated with a first laser beam. The semiconductor film is radiated with a second laser beam after radiating with the first laser

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beam under an atmosphere comprising one of hydrogen and an inert gas, and radiated with a third laser beam after radiating with the second laser beam. A wavelength of the second laser beam and a wavelength of the third laser beam are different from a wavelength of the first laser beam.

The Examiner appears to take the position that Mitnaga discloses the step of "radiating the semiconductor film with a second laser beam after radiating with the first laser beam under an atmosphere comprising one of hydrogen and an inert gas," as recited in claim 7. Applicant respectfully disagrees.

Not only does Mitnaga fail to cure the deficiencies of Nitta as set forth above, the Examiner has not provided any of the required motivation as to why one having ordinary skill in the art would be motivated to modify Nitta given the teachings of Mitnaga. Furthermore, to modify Nitta as it appears the Examiner contends would render Nitta inoperable for its intended purpose as Nitta discloses the use of laser diodes not laser beams as fully set forth above.

With regard to claims 8-9, 11, Applicant respectfully submits that the dependent claims have been amended to overcome the Examiner's objection of functional recitation in a similar manner to claims 2-4.

The combination of Nitta and Mitnaga also fail to disclose the subject matter of claims 13-15, 17, 25-28 and 31-33, for the reasons set forth above. Namely, neither Nitta nor Mitnaga, either alone or in combination disclose the claimed subject matter and no motivation exists to combine the references as suggested by the Examiner.

Claims 4, 6, 10, 12, 16, 18-24, 29-30 and 34-36 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Nitta and in view of Mitnaga and further in view of U.S. Patent No. 4,879,176 to Ouderkirk et al. ("Ouderkirk"). These rejections are respectfully traversed at least for the reasons provided below.

Claims 4, 10, 16, 20-22, and 32-34 have also been amended to overcome the Examiner's objection to functional recitation. Ouderkirk fails to cure the deficiencies of Nitta and/or Mitnaga as it does not disclose the claimed steps of the independent claims 1, 7, 13, 19, 25 and 31.

The Examiner has also failed to provide any motivation as to why one having ordinary skill in the art would be motivated to modify and combine the above references as

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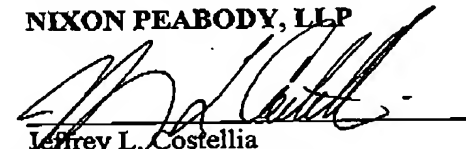
suggested.

In summary, the Examiner has not demonstrated: the proper motivation and suggestion for combining the cited references; how to modify the different teachings of the cited references; and a reasonable expectation of success in combining the different inventions. Therefore, a *prima facie* case of obviousness has not been properly established.

In view of the foregoing, it is respectfully submitted that the claims are allowable over the cited prior art and it is requested that the rejections and warning of record be reconsidered and withdrawn by the Examiner, that the pending claims be allowed and a notice of allowance issued.

Respectfully submitted,

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